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| 10/039,482      | 11/09/2001  | Jimmy G. Bassett     | 32887/265439        | 9777             |

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09/09/2005

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EXAMINER

ALLEN, MARIANNE P

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,482

Applicant(s)

BASSETT ET AL.

Examiner

Marianne P. Allen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-136 is/are pending in the application.
- 4a) Of the above claim(s) 4-13 and 23-121 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 14-22 and 122-136 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-136 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/15/05 and the supplemental submission on 6/22/05 have been entered.

Claims 131-136 have been newly introduced.

Applicant's arguments filed 4/15/05 and 6/22/05 have been fully considered but they are not persuasive.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

Claims 4-13 and 23-121 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of copending Application No. 09/805,261. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims embrace systems and processes for manipulating chemical product, function, or service input information to produce chemical product, function, or service output by using the internet. Implicit in the co-pending system is the computer readable medium of claim 3.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 112***

Claims 1-3 and 131-136 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The 4/15/05 submission amended claim 1 to recite "operable to perform a calculation on the input data." No basis is seen in any of the sections pointed to by applicant for this limitation.

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It does not appear that the specification discloses any calculations on input data per se.

Clarification is requested.

The 6/22/05 submission adds claims 131-136 directed to "ternary analysis." No basis is seen in any of the sections pointed to by applicant for this limitation. While Figure 7G shows a particular trilinear analysis for a particular component blend (see for example specification at page 22, first complete paragraph and at page 25, second complete paragraph) this is not sufficient basis for the generic concept as set forth in the claims.

Claims 1-3, 14-22, and 122-136 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This is an enablement rejection.

This rejection is maintained for reasons of record as applied to claims 1-3 and 14-22 in the prior Office action.

As set forth in the prior Office actions, no guidance for developing predictive algorithms or models is provided. The specification and prior art of record does not demonstrate that trilinear analysis to predict standard adhesive properties was routinely used by those of ordinary skill in the art for component blends and standard adhesive properties other than that exemplified. With respect to claims 1-3, the specification does not disclose performing calculations on input data per se. With respect to claims 131-136, the specification does not disclose ternary analysis.

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Applicant asserts that the amendment provides sufficient guidance. However, it is the originally filed specification that must provide guidance.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-19, 123-126, and 129 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 is confusing in the way the claim is structured. Line 2 recites "said processing module comprising." However, the body of the claim refers to both the processing module and and output module. The system of claim 1 does not have an output module contained within the processing module. Clarification is requested.

Claim 123 does not appear to further limit the subject matter of claim 122 as the input is already required to be a formulation of at least one component blend. Likewise, claim 129 does not appear to further limit the subject matter of claim 128. Clarification is requested.

Claim 126 is confusing in reciting "at least on graphical representation." It appears that the claim may contain a typographical error.

#### ***Claim Rejections - 35 USC § 102***

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Tambay et al. (US 2001/0037255 A1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

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102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Applicant is not entitled to benefit of provisional application 60/247,537 filed 9 November 2000 for claims instant 14-22 and 122-136. Tambay et al. is entitled to benefit of provisional application 60/189,156 filed 14 March 2000 for the disclosure relied upon in support of the rejection of claims 1-3.

Claims 1-3 are anticipated by Tambay et al. (US 2001/0037255 A1) as Tambay et al. discloses systems and processes for manipulating chemical product, function, or service input information to produce chemical product, function, or service output by using the internet. Implicit in the co-pending system is the computer readable medium of claim 3. See figures, abstract, and claims.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Moore et al. (U.S. Patent No. 6,304,869).

Moore et al. discloses a relational database management system (including computer-readable medium containing computer-executable instructions, system and method of use) for chemical structure storage, searching, and retrieval. Input, output, and processing modules are disclosed. The data output relates to a chemical product. (See at least abstract, claims, and figures.)

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Although the claim recites “for accepting input data over an extranet or internet” the input module in the system of Moore et al. would be implicitly capable of accepting input data from any source. As the input is acted upon by the system to produce output, the limitation “operable to perform a calculation on the input data” is deemed to be met.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Guskov et al. (US 2002/0082753 A1).

Guskov et al. was filed 8/3/2001. This application claims and is entitled to benefit of provisional application 60/222,890, filed 8/30/2000 for the disclosure relied upon.

Guskov et al. discloses an E-commerce method of doing business, particularly directed to configuring spray coating systems. The central E-Commerce site is connected over the internet. Customers access the system via the internet connection. They provide provide chemical product, function, or service input data such as number of colors, type of powder, etc. The E-Commerce site uses that information to design the system for the customer meeting the limitation of output data relating to the chemical production, function, or service. See for example Figure 5C and abstract.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 14-22, and 122-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quinn et al. (US 2003/0139516 A1) in view of Gorman et al. (US 2002/0078103 A1).

Quinn et al. (US 2003/0139516 A1) discloses improving hot melt adhesives. Figure 1 shows a trilinear contour plot generated from an experimental design illustrating the change in peel value as the types of resin and the amounts are varied. See paragraph [0021] and [102]-[107]. Various adhesive tests are performed. See paragraphs [0068]-[0086]. Tabular data on adhesive properties is disclosed. See Tables. Such adhesive compositions are commercially useful products. See paragraph [0066]. Quinn et al. does not disclose an internet or extranet based system, computer-readable medium containing computer-executable instructions, or method for providing adhesive compositions.

Gorman et al. (US 2002/0078103 A1) discloses a wizard development kit to provide an environment for deploying web-based applications to end users. See at least abstract, figures, and claims.

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It would have been obvious to create software enabled wizards, systems, and methods of using them to select adhesives with particular properties based on their component blends over the internet as a more efficient business model. Quinn et al. teaches the experimental design or model for hot melt adhesives where properties can be predicted based upon chemical composition. Gorman et al. demonstrates that it would have been well known in the art how to produce wizard applications. The specification itself acknowledges the desirability of web-based commerce in the background of the invention. One would have been motivated to automate the experimental design results of Quinn et al. to make adhesive compositions with particular properties more readily available to customers.

Claims 1-3, 14-22, and 122-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quinn et al. (US 2003/0139516 A1) in view of Tambay et al. (US 2001/0037255 A1).

Quinn et al. is applied as above. Quinn et al. does not disclose an internet or extranet based system, computer-readable medium containing computer-executable instructions, or method for providing adhesive compositions.

Tambay et al. is applied as above and further teaches including a formulation determination calculator or wizard to meet the needs of the adhesive industry. See paragraphs [0020-0022, 0069-0070, 0102-105, 0117-0119].

It would have been obvious to create software enabled wizards, systems, and methods of using them to select adhesives with particular properties based on their component blends over the internet as a more efficient business model as suggested by Tambay et al. Quinn et al. teaches the experimental design or model for hot melt adhesives where properties can be

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predicted based upon chemical composition. Tambay et al. demonstrates that it would have been desirable to produce formulation calculators or wizard applications for adhesives. The specification itself acknowledges the desirability of web-based commerce in the background of the invention. One would have been motivated to automate the experimental design results of Quinn et al. to make adhesive compositions with particular properties more readily available to customers.

### ***Conclusion***

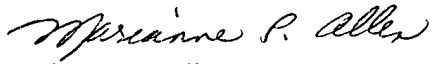
No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph.D., can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

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Marianne P. Allen  
Primary Examiner  
Art Unit 1631  
9/6/05

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